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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,778	03/04/2004	Chin Sung Ko	MR1197-610	4406

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3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER

HAWK, NOAH CHANDLER

ART UNIT PAPER NUMBER

3637

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,778	<b>Applicant(s)</b> KO, CHIN SUNG	
	<b>Examiner</b> Noah C. Hawk	<b>Art Unit</b> 3637	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant fails to describe the use of the umbrella runner device of Claim 3 as it is portrayed in Figure 7. When the runner is raised up the umbrella pole, the top lip of the runner (1) will inevitably get caught on the bottom edge of the lower tube (32), thereby preventing the runner from reaching the gap between the two tubes and rendering the device inoperable.

### ***Claim Rejections - 35 USC § 102***

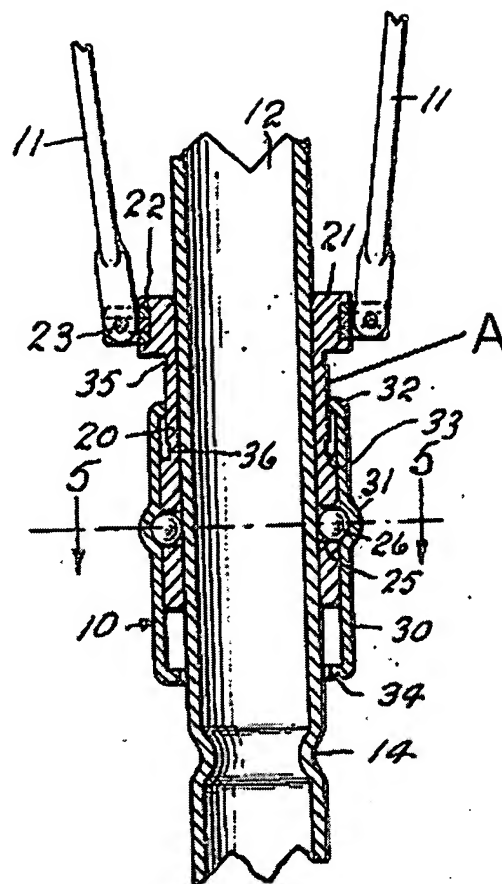
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Katzberg in US Patent 2528003.

a. Regarding Claim 1, Katzberg discloses an engaging structure for an umbrella including a runner (encompassing 10 and 20) having a plurality of side apertures (25) formed on an inner circumference thereof, said runner having formed on an outer circumference thereof a positioning ring (A, Best seen in Katzberg, Figure 2, below), a plurality of balls (26) each received in a corresponding one of said apertures, a sleeve (30) slidably displaceable on said outer circumference of said runner, said sleeve including an upper opening (the opening at drawing line 5-5 in Figure 2) and an inner middle edge (the edge at drawing line 6-6 in Figure 3) having smaller diameter relative to a diameter of said upper opening, said sleeve having an inner low projective ring (32) formed on an inner circumference thereof so as to be selectively positioned on either of opposing sides of said positioning ring and a shaft (12) received in said inner circumference of said runner and having an annular concave portion (14) for receiving said balls therein, said balls being maintained in said annular concave portion by said middle edge of said sleeve when said projective ring is on a first one of said opposing sides of said positioning ring and said balls are received in said upper opening when said projective ring is on a second one of said opposing sides of said positioning ring.



Katzberg '003, Figure 2

- b. Regarding Claim 2, Katzberg '003 discloses that the shaft is provided with several grooves (13, 14) spaced apart around the circumference thereof for engaging with said balls.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katzberg '003 as applied to Claim 1 above. As stated above, Katzberg '003 teaches all of the limitations of Claim 1 including an umbrella runner but does not teach the use of two tubes as an engaging means for the balls. However, the two tubes mounted on the shaft in spaced relationship to form an annular recessed portion therebetween are an obvious variation of the single sleeve with an annular concave portion of Katzberg. The use of two tubes in spaced relationship on the shaft serves the same function as the groove taught by Katzberg: an annular concave portion is formed for receiving the balls, retaining the runner. Further, the shape of the annular concave portion formed by two tubes in spaced relationship could be identical to that of a concave groove machined by a lathe into a shaft by a square-ended cutting tool, and the manufacture of a shaft with two tubes in spaced relationship would be easier to accomplish than that of a shaft with an integral groove.

***Response to Arguments***

7. Applicant's arguments filed 1/25/06 have been fully considered but they are not persuasive.

8. Regarding the 112, 1<sup>st</sup> paragraph rejection: the user of the umbrella shown in figure 3 would still encounter resistance as explained above, even without the presence of the "convex" portion. It is assumed that the normal use of this device will be a user engaging the runner from one side and probably imparting a force to motivate the runner off the axis of the shaft (away from the user). Unless the user can keep the runner in near perfect concentricity with the bottom tube, the top inside corner of the runner 1 will encounter the bottom outer corner of the lower tube (shown in the figure as 32).
9. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noah C. Hawk whose telephone number is 571-272-1480. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NCH  
NCH  
3/24/06

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
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*Lanna Mai*